

REMARKS

Claims 15-17 and 23-28 are pending in the application.

Claims 15-17 and 23-28 stand rejected.

Claims 15-17, 23 and 26-28 have been amended.

Rejection of Claims under 35 U.S.C. §103

Claims 15, 16, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *User's Guide for Microsoft Project*, 1995 (Microsoft Project) in view of *Using Microsoft Project 4*, 1994 (Project 4) in view of Ferriter, et al., European Patent No. EP 0 314 596 B1 (Ferriter).

While not conceding that the cited references qualify as prior art, but instead to expedite prosecution, Applicant has chosen to respectfully disagree and traverse the rejection as follows. Applicant reserves the right, for example, in a continuing application, to establish that the cited references, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

As an initial matter, claims 15, 23 and 26 have been amended to recite that the claimed method (or system) is directed to the steps in managing the release of a product, as is reflected in the discussion in the Specification. Thus, a number of inconsistencies and inaccuracies result when one attempts to compare the cited references and the claimed invention.

The cited references are directed at task management, generally. However, particularly as amended (but even without such amendments), the claimed processes and system are directed to the control of a software creation and release process (to wit: a “Feature Centric Release Manager Method And System,” as the title of the present application indicates). This is in no way comparable to the much-simpler subject of project management, as represented by the general approach disclosed in the cited references. Such is the case at least because the process is based on the product’s features. Insofar as Applicant is able to discern, the cited references fail to show, teach or suggest that a project might be based on a set of a product’s features. Nowhere in the cited references is there shown, taught or suggested a method and system for monitoring the development and release of a product, based on that product’s features. As the examples in the Specification show, it is that portion of a product’s lifecycle between creation and release that is the focus of the claimed invention.

The cited references discuss project management in general terms, but fail to describe a method or system that is keyed on a products features. This can be important, for example, in the situation in which a software program is to be released, and a number of features must be designed, implemented, approved and released, typically in parallel with one another (meeting only in the final product, and subsequently being analyzed as the final version, with all the features to be released). While such limitations were clear in the pending claims, Applicants have amended the independent claims to further clarify this distinction (certain dependent claims

have also been amended for clarity). This can be seen, for example, in amended independent claim 15:

15. A method comprising:
managing a release of a product, comprising
describing the product in terms of a plurality of product features of the product;
entering a description of each of said product features, wherein said description
comprises an instantiation of a feature list graphical user interface;
defining a plurality of tasks, wherein each of said tasks is associated with one of
said product features, the plurality of tasks being grouped into task types;
linking each of the plurality of tasks with one of the plurality of product features;
entering a task progress development as an instantiation of a task-type graphical
user interface, wherein the task-type graphical user interface is selected
from a plurality of task-type graphical user interfaces, each corresponding
to one of the task types; and
tracking a status of each product feature via the instantiated task-type graphical
user interfaces.

As can be seen, the language of the amended independent claims (of which claim 15 is an example) is directed to managing the release of a product, and achieves this in part by managing the process based on the product's features. No such concept is shown, taught or suggested anywhere in the cited portions of the cited references.

Applicant therefore respectfully submits that the Office Action does not establish the presence of these limitations in Microsoft Project in view of Project 4, in further view of Ferriter, taken alone or in any permissible combination. The Office bears the burden to support a case of

obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See MPEP 706.02(j).* Applicants therefore respectfully submits that, for the reasons presented above, Microsoft Project, Project 4 and Ferriter, alone or in combination, teach the limitations of amended independent claims 15, 23 and 26.

In addition, Applicants also respectfully submit that the Office Action fails to satisfy the burden of factually supporting the alleged motivation to combine the references. As an initial matter, Applicants agree that the following limitations are not shown, taught or suggested by Microsoft Project and/or Project 4, taken alone or in any permissible combination:

“...

describing the product in terms of a plurality of product features of the product;

...

linking each of the plurality of tasks with one of the plurality of product features;

....”

This comes as no surprise, given that, as noted, Microsoft Project and Project 4 completely fail to recognize that product features of a product can be used as a basis for managing the creation and release of a product, as recited in the claimed invention. It is said that Ferriter provides teaching such limitations. Applicants respectfully disagree. Ferriter merely provides for the display of a product's features. (Ferriter, Figs. 5-7) Applicants are unable to discern any showing, teaching or suggestion in which Ferriter describes or insinuates that such features can be used as a basis for managing the creation and release of a product displayed thereby, as recited in the claimed invention.

Moreover, the Office's duty may not be satisfied by engaging impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Applicants respectfully submit that the particular parts of the cited references relied upon by the Examiner and the pertinence of each reference has not been clearly explained, especially with regard to the motivation to combine references in on page 4 of the Office Action. Further, the Office action does not establish that such a combination of the teachings of these references would meet with success, as required.

Moreover, the motivation suggested to be provided by Ferriter is “..., in at least the background of his invention [a disclosure of] project management software and procedures already established in the industry.” This statement is deficient for a number of reasons. First and foremost, there is still no showing, teaching or suggestion that such would result in the claimed invention, as noted, both because there is no teaching or feature-based product development/release management, and because even if there is motivation therein, the resulting combination would still be just a project management program (a point Applicant does not even concede). Second, the aforementioned citation is nebulous, at best, and demands that the Applicant go looking through the background in question, to locate evidence propounded by the Examiner, when such evidence has not been provided. Third, as noted earlier, this conclusory statement fails to meet the requisite burden, and even if such were the case, the result would still be simply a project management program, a far cry from the claimed invention.

Applicants respectfully submit that such an argument therefore fails to establish a *prima facie* case of obviousness and runs perilously close to a forbidden hindsight analysis of the references. The Office Action makes no showing of a motivation to combine Ref1 with Ref2 from within the references themselves; therefore, it must be presumed that there is none. It is well-established that the best defense to hindsight is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *See Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be “clear and particular” and “broad conclusive statements about the teaching of multiple references, standing alone, are not ‘evidence.’” *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.”

Ruiz, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field. Nor does the Office Action present any evidence of a problem to be solved from within those references themselves.¹

¹ There must be a finding that “there was a disadvantage to the prior systems, such that the ‘nature of the problem’ will have motivated a person of ordinary skill to combine the prior art references.” *Id.* at 666.

Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teaching of Applicants' own disclosure.

Using Applicants' own disclosure as a blueprint for providing the motivation to combine prior art references in an obviousness determination is impermissible. *See W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

For these reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of claims 15 and 26, and all claims dependent upon them, and that they are in condition for allowance. Applicants therefore request the Examiner's reconsideration of the rejections to those claims.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *User's Guide for Microsoft Project*, 1995 (Microsoft Project) and *Using Microsoft Project 4*, 1994 (Project 4), in view of Ferriter, et al., European Patent No. EP 0 314 596 B1 (Ferriter), and further in view of Eisener, *The Essentials of Project and Systems Engineering Management*, 1997 (Eisener). Given that the basis of this rejection is that used in the rejection of claims 15, 16, 26 and 27, Applicants respectfully traverse these rejections, for at least the reasons provided with regard to claims 15, 16, 26 and 27.

Claims 17 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *User's Guide for Microsoft Project*, 1995 (Microsoft Project), *Using Microsoft Project 4*, 1994 (Project 4), and Ferriter, et al., European Patent No. EP 0 314 596 B1 (Ferriter), further in view of Kroenke, *Database Processing: Fundamentals, Design, and Implementation*, 1988 (Kroenke).

Given that the basis of this rejection is that used in the rejection of claims 15, 16, 26 and 27, Applicants respectfully traverse these rejections, for at least the reasons provided with regard to claims 15, 16, 26 and 27.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *User's Guide for Microsoft Project*, 1995 (Microsoft Project), *Using Microsoft Project 4*, 1994 (Project 4), and Eisener, *The Essentials of Project and Systems Engineering Management*, 1997 (Eisener), further in view of Kroenke, *Database Processing: Fundamentals, Design, and Implementation*, 1988 (Kroenke). Given that the basis of this rejection is that used in the rejection of claims 15, 16, 26 and 27, Applicants respectfully traverse these rejections, for at least the reasons provided with regard to claims 15, 16, 26 and 27.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5084.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 27, 2006.



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Date of Signature

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